

Appl. No. 09/998,396
Substitute Appeal Brief dated 01/05/2007
Reply to Office Action of 12/05/2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Application of:	:
Keohane et al.	:
	: Before the Examiner:
Serial No: 09/998,396	: Kyle R. Stork
	:
Filed: 11/15/2001	: Group Art Unit: 2178
	:
Title: APPARATUS AND METHOD	: Confirmation No.: 7309
OF HIGHLIGHTING PARTS OF WEB	:
DOCUMENTS BASED ON	:
INTENDED READERS	:

SUBSTITUTE APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a response to a Notification of Non-Compliant Appeal Brief dated
December 05, 2006.

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BRIEF FOR APPLICANTS - APPELLANTS

(i)

Real Party in Interest

The real party in interest is International Business Machines Corporation (IBM), the assignee.

(ii)

Related Appeals and Interferences

There are no other appeals or interferences known to appellants, appellants' representative or assignee, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(iii)

Status of Claims

Claims 1 - 20 have been finally rejected. This appeal involves all the rejected claims.

(iv)

Status of Amendment

An amendment was not filed after the Final Office Action.

(v)

Summary of Claimed Subject Matter

The Application contains four sets of claims of equal scope. The first set is a set of method claims (i.e., Claims 1 – 3, 13 and 14), the second set is a set of computer program product claims (Claims 4 – 6, 15 and 16), the third set is a set of apparatus claims (Claims 7 – 9, 17 and 18) and the fourth is a set of system claims (Claims 10 – 12, 19 and 20).

The present invention, as claimed in independent Claim 1, provides a method of highlighting parts of a Web document based on an intended reader (see page 9, lines 20 – 22). According to the teachings of the invention, when a document that has at least one section to be highlighted based on an intended reader, the document is displayed with a button. The button is associated with a section indicating the intended user. When the button is asserted, the section is highlighted (see page 11, line 5 to page 12, line 5, page 13, lines 18 – 30 as well as Figs. 5A, 5B, 5C, 5E, 5D and 6).

The present invention, as claimed in independent Claims 4, provides a computer program code of highlighting parts of a Web document based on an intended reader (see page 9, lines 20 – 22). According to the teachings of the invention, when a document that has at least one section to be highlighted based on an intended reader, the document is displayed with a button. The button is associated with a section indicating the intended user. When the button is asserted, the section is highlighted (see page 11, line 5 to page 12, line 5, page 13, lines 18 – 30 as well as Figs. 5A, 5B, 5C, 5E, 5D and 6). Note that the code means plus function of the claim are the steps outlined on page 13, lines 18 - 30 as well as in Fig. 6.

The present invention, as claimed in independent Claim 7, provides an apparatus for way of highlighting parts of a Web document based on an intended reader (see page 9, lines 20 – 22). According to the teachings of the invention, when a document that has at least one section to be highlighted based on an intended reader, the document is displayed with a button. The button is associated with a section indicating the intended user. When the button is asserted, the section is highlighted (see page 11, line 5 to page 12, line 5, page 13, lines 18 – 30 as well as Figs. 5A, 5B, 5C, 5E, 5D and 6). The means plus functions of Claims 7 – 9, 17 and 18 are the steps outlined on page 13, lines 18 - 30 as well as in Fig. 6 when processed by processors 202, 204 and 302.

The present invention, as claimed in independent Claim 10, provides a system for highlighting parts of a Web document based on an intended reader
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(see page 9, lines 20 – 22). According to the teachings of the invention, when a document that has at least one section to be highlighted based on an intended reader, the document is displayed with a button. The button is associated with a section indicating the intended user. When the button is asserted, the section is highlighted (see page 11, line 5 to page 12, line 5, page 13, lines 18 – 30 as well as Figs. 5A, 5B, 5C, 5E, 5D and 6).

(vi)

Grounds of Rejection to be Reviewed on Appeal

Whether Claims 1, 4, 7, 10, 13, 15, 17 and 19 were properly rejected under 35 USC §102(a) as being anticipated by Adobe GoLive™ 5.0 User Guide

Whether Claims 2, 3, 5, 6, 8, 9, 11, 12, 14, 16, 18 and 20 were properly rejected under 35 USC §103(a) as being unpatentable over Adobe GoLive™ 5.0 User Guide in view of Microsoft™ Word™

(vii)

Arguments

Whether Claims 1, 4, 7, 10, 13, 15, 17 and 19 were properly rejected under 35 USC §102(a) as being anticipated by Adobe GoLive™ 5.0 User Guide

Adobe GoLive 5.0 User Guide mainly explains how users may use certain options/features available in Adobe GoLive 5.0. For example, if a user wants to select viewing options using the View Controller in Adobe GoLive, the user is instructed to choose Window then View Controller. From View Controller there is a list of options from which the user may choose. The list goes from an option to select invisible items so that invisible items (such as line breaks etc.) may show on an open page to an option to highlight elements on the page that is formatted with a specific class or ID or a specific tag.

Thus, the Adobe GoLive 5.0 User Guide provides instructions that call for a user to go through (drop down) menus until a desired option is displayed, then and only then may the user select the option.

By contrast, the present invention contains the limitations of displaying at least one button with the document that is not only associated with a section of the document but also indicates an intended user. When the intended user depresses the button the section of the document with which the button is associated is highlighted.

Note that indicating the intended user is a rather important aspect of the invention since only one document that has different sections that are each to be reviewed by a different user is used.

In the Examiner's Answer of November 21, 2005 the Examiner, referring to the reference, stated that "[h]ere, a user can assert a button to highlight all items tagged with a specific class, ID, or tags. As the Applicant discloses in paragraphs 0037-0038 of the specification, the highlighting occurs between specific HTML tags." (See second bullet on page 5 of the Examiners Answer.)

Firstly, Applicants would like to point out that the claimed element includes the limitations of ***displaying at least one button with the document, the at least one button being associated with the at least one section of the document and indicating the intended user***. It does not state that a user can assert a button to highlight all items tagged with a specific class, ID or tags as asserted by the Examiner. Therefore, whether or not a user can do so is irrelevant.

In considering a Section 102 rejection, all the elements of the claimed invention must be disclosed in a single item of prior art ***in the form literally defined in the claim***. *Jamesbury Corp. v. Litton Indus. Products*, 756 F.2d 1556, 225 USPQ 253 (Fed. Cir. 1985); *Atlas Powder Co. v. Dupont*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); *American Hospital Supply v. Travenol Labs.*, 745 F.2d 1, 223 USPQ 577 (Fed. Cir. 1984).

In this particular case, Adobe GoLive 5.0 User Guide fails to disclose the above-mentioned element in the form literally defined in the claim and therefore cannot have anticipated the claimed invention.

Nevertheless it should be pointed out that the Examiner stated that in paragraphs 0037-0038, Applicants disclose that the highlighting occurs between specific HTML tags. However, The Examiner fails to point out that in paragraphs 0035 and 0036 (i.e., page 12, line 17 to page 13, line 9), Applicants disclose that each button is labeled with an intended user and that when a button is asserted the label used to indicate the intended user is used by the invention as a search term in order to determine which part of the text is to be highlighted. Thus and as mentioned above, having buttons indicating intended users is a rather important part of the invention and should not be overlooked as the Examiner seems to have done.

Secondly, the part of the reference relied upon by the Examiner states:

11. Choose an option from the Mark Style menu to highlight elements on the page formatted with a specific class or ID.
12. Choose an option from the Mark Element menu to highlight elements on the page formatted with a specific tag.

Nowhere in the above-reproduced passages is there a teaching of using a **button** as claimed by the Examiner, let alone a button that identifies an intended user or that is associated with a section of the document.

Therefore, the Adobe GoLive 5.0 User Guide does not teach, show or so much as suggest the step of ***displaying at least one button with the document, the at least one button being associated with the at least one section of the document and indicating the intended user.*** Consequently, Applicants submit that the claims in the Application are allowable.

Whether Claims 2, 3, 5, 6, 8, 9, 11, 12, 14, 16, 18 and 20 were properly rejected under 35 USC §103(a) as being unpatentable over Adobe GoLive™ 5.0 User Guide in view of Microsoft™ Word™

Claims 2, 5, 8 and 11

Claims 2, 5, 8 and 11 include the limitations of “wherein highlighting the section entails graying out the document except the section.”

The Examiner admitted that Adobe GoLive™ 5.0 User Guide does not disclose those limitations. However, the Examiner used Microsoft™ Word™ to show the limitations. More precisely, the Examiner stated that when the header/footer of a document is selected in Microsoft™ Word™, the body of the document is grayed out. Therefore, the Examiner reasoned, combining the teachings of Microsoft™ Word™ with those of Adobe GoLive™ 5.0 User Guide shows the invention.

It is a well settled law that in considering a Section §103 rejection, the subject matter of the claim “as a whole” must be considered and analyzed. In the analysis, it is necessary that the scope and contents of the prior art and differences between the art and the claimed invention be determined. *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

The invention calls for highlighting a section of a document by graying out the document except the section. However, the highlighting only occurs when a button indicating an intended user is asserted.

By contrast and based on the Examiner's assertions, when the teachings of the Adobe GoLive™ 5.0 User Guide are combined with those of Microsoft™ Word™, a user can assert a button to highlight all items tagged with a specific class, ID, or tags. Then, the user can select the header/footer of the document to gray out the body of the document. This is quite different from the claimed invention.

Applicants submit that the combination of the two references does not teach the claimed invention.

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Claims 14, 16, 18 and 20

Claims 14, 16, 18 and 20 include the limitations of “wherein when the at least one button is asserted, a string is sent to a search engine, the string indicating the tags for which the search engine is to search.”

Again, the Examiner admitted that Adobe GoLive™ 5.0 User Guide does not disclose those limitations. However, the Examiner used Microsoft™ Word™ to show the limitations. In this case, the Examiner stated that when a word is entered into the “Find” search box of Microsoft™ Word™, the search engine of Microsoft™ Word™ then searches the document to find the next data item matching the search string. Therefore, the Examiner reasoned, combining the teachings of Microsoft™ Word™ with those of Adobe GoLive™ 5.0 User Guide shows the invention.

As stated before, in considering a Section §103 rejection, the subject matter of the claim “as a whole” must be considered and analyzed. In the analysis, it is necessary that the scope and contents of the prior art and differences between the art and the claimed invention be determined. *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

The invention calls for a string to be sent to a search engine. The string indicates the tags for which the search engine is to search. But, the string is sent to the search engine when the button indicating an intended user is asserted.

Again, based on the Examiner’s assertions, when the teachings of the Adobe GoLive™ 5.0 User Guide are combined with those of Microsoft™ Word™, a user can assert a button to highlight all items tagged with a specific class, ID, or tags. Then, the user can enter a word into the “Find” search box of Microsoft™ Word™ to find the next data item matching the search string. Applicants fail to see how the combination shows the claimed invention.

Applicants again submit that the combination of the two references does not teach the claimed invention.

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Based of the foregoing, Applicants respectfully request allowance and passage to issue of the claims in the application.

Respectfully Submitted

By: 

Volel Ernile
Attorney for Applicants
Registration No. 39,969
(512) 306-7969

(viii)

Claims Appendix

1. (Previously presented) A method of displaying a document having at least one section that is to be highlighted based on an intended user comprising the steps of:

displaying the document;

displaying at least one button with the document, the at least one button being associated with the at least one section of the document and indicating the intended user; and

highlighting the at least one section of the document when the at least one button is asserted.
2. (Original) The method of Claim 1 wherein highlighting the section entails graying out the document except the section.
3. (Original) The method of Claim 1 wherein highlighting the section entails displaying the section in a different color.
4. (Previously presented) A computer program product on a computer readable medium for displaying a document having at least one section to be highlighted based on an intended user comprising:

code means for displaying the document;

code means for displaying at least one button with the document, the at least one button being associated with the at least one section of the document and indicating the intended user; and

code means for highlighting the at least one section of the document when the at least one button is asserted.

5. (Original) The computer program product of Claim 4 wherein highlighting the section entails graying out the document except the section.

6. (Original) The computer program product of Claim 4 wherein highlighting the section entails displaying the section in a different color.

7. (Previously presented) An apparatus for displaying a document having at least one section to be highlighted based on an intended user comprising:

means for displaying the document;

means for displaying at least one button with the document, the at least one button being associated with the at least one section of the document and indicating the intended user; and

means for highlighting the at least one section of the document when the at least one button is asserted.

8. (Original) The apparatus of Claim 7 wherein highlighting the section entails graying out the document except the section.

9. (Original) The apparatus of Claim 7 wherein highlighting the section entails displaying the section in a different color.

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10. (Previously presented) A computer system for displaying a document having at least one section to be highlighted based on an intended user comprising:

at least one memory device for storing code data; and

at least one processor for processing the code data to display the document with at least one button, the at least one button being associated with the at least one section of the document and indicating the intended user, and to highlight the at least one section of the document when the at least one button is asserted.

11. (Original) The computer system of Claim 10 wherein highlighting the section entails graying out the document except the section.
12. (Original) The computer system of Claim 10 wherein highlighting the section entails displaying the section in a different color.
13. (Previously presented) The method of Claim 1 wherein the at least one section to be highlighted is within a pair of tags.
14. (Previously presented) The method of Claim 13 wherein when the at least one button is asserted, a string is sent to a search engine, the string indicating the tags for which the search engine is to search.
15. (Previously presented) The computer program product of Claim 4 wherein the at least one section to be highlighted is within a pair of tags.

16. (Previously presented) The computer program product of Claim 15 wherein when the at least one button is asserted, a string is sent to a search engine, the string indicating the tags for which the search engine is to search.
17. (Previously presented) The apparatus of Claim 7 wherein the at least one section to be highlighted is within a pair of tags.
18. (Previously presented) The apparatus of Claim 17 wherein when the at least one button is asserted, a string is sent to a search engine, the string indicating the tags for which the search engine is to search.
19. (Previously presented) The computer system of Claim 10 wherein the at least one section to be highlighted is within a pair of tags.
20. (Previously presented) The computer system of Claim 19 wherein when the at least one button is asserted, a string is sent to a search engine, the string indicating the tags for which the search engine is to search.

(ix)

Evidence Appendix

No evidence was submitted pursuant to 37 C.F.R. §§ 1.130, 1.131 and 1.132 nor was there any evidence entered by the Examiner relied upon by Appellants in this appeal.

(x)

Related Proceedings Appendix

There are no decisions rendered by a court or the Board that would have a bearing on the Board's decision in the pending appeal.